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CASE :PH7167 US - DIV [1]



FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

JOHN DUNCIA, ET AL

PATENT NO.: 6,984,651

ISSUED: 1/10/06

APPLICATION NO: 10/635946

FILED: 08/07/2003

FOR: PIPERIDINE AMIDES AS MODULATORS OF
CHEMOKINE RECEPTOR ACTIVITY

ART UNIT: 1625

EXAMINER: CHANG, CELIA C

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO CORRECT PATENT TERM ADJUSTMENT
PERIOD IN GENERATED PATENT UNDER 37 C.F.R. §1.181**

Sir:

The granted patent erroneously lists the patent term adjustment period as 0 days. Applicants respectfully request that this determination be reconsidered.

The patent term adjustment history from PAIR shows a USPTO delay of 114 days following the payment of the issue fee and Applicant delay of 120 days following payment of the issue fee. It is respectfully submitted that Applicants' delay should only be 0 days, thereby giving a patent term adjustment of 114 days - 0 days, or 114 days.

PAIR lists an Applicant delay of 120 days for a Miscellaneous Incoming Letter which was received by the Patent Office on June 3, 2005, after the Notice of Allowance was mailed on February 22, 2005. This Miscellaneous Incoming Letter was a Letter to the File. The Letter to the File required no further action on the part of the USPTO, other than placing the Letter into the file. Therefore, it is believed that this Letter should not be counted as a delay in the prosecution of the application and should not be counted against Applicants in a Patent Term Adjustment determination.

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The MPEP §2732 lists examples of submissions after Notice of Allowance which will count as reduction of patent term adjustment and those that will not count toward a reduction. Furthermore, in the Official Gazette, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001, clarification of what constitutes a delay after Notice of Allowance is presented. The Official Gazette states that "... submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application." A Letter to the File is not specifically listed in the examples in either the MPEP or the Official Gazette. However, Applicants submit that the submission of a Letter to the File is not a "substantial interference and delay" in the patent process that should trigger a reduction of patent term adjustment under 37 CFR §1.704(c)(11).

Accordingly, the Patent Term Adjustment History should be adjusted to read 114 days of delay due to the USPTO after the payment of the issue fee and 0 days of delay due to Applicants after the payment of the issue fee, giving a total 114 days of Patent Term Adjustment to Applicants.

Inasmuch as Applicant believes this error is ascribable to the Patent Office, Applicant is requesting reconsideration of the patent term adjustment to 114 days. This petition is being filed within two months of the date of the issued patent under 1.705(d). Accordingly, no fees are required. However, if this is incorrect, the Commissioner is hereby authorized to charge the \$200 fee under 37 C.F.R. §1.18(e) and any additional fees that may be required to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Enclosed is a copy of the cover page of the patent.

Respectfully submitted,

Mary Van Atten

Mary K. VanAtten
Attorney for Applicant
Reg. No. 39,408
Phone: 609-252-4379
Date:

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000